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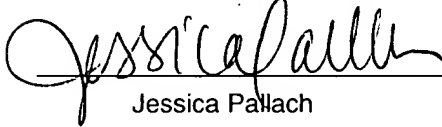
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Jessica Pallach

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: SHENHOLZ, G.

Docket No.: EFIM0209CPA

Serial No. : 09/030,825

Art Unit: 2673

Filed: 26 FEBRUARY 1998

Examiner: Shankar, V.

Title: PRESENTATION BOARD DIGITIZIER SYSTEMS

December 1, 2000

Assistant Commissioner for Patents

BOX NON FEE

Washington, DC 20231

RESPONSE

Sir:

This is in response to the Office Action (Paper No. 14) mailed on October 12, 2000. The Applicant respectfully requests the Examiner to consider this response and enter this response into the formal record of the instant case. Applicant proffers this response on the basis that this amendment places the application in condition for allowance.

1. The Applicant thanks the Examiner for the Examiner's comments which have greatly assisted Applicant in responding.
2. Claims 16, 18, and 19 have been rejected under 35 USC § 103(a). This rejection has been made in reliance on Murakami (U.S. Patent No. 5,023,408) in further view of Stefik et al. (U.S. Patent No. 4,814,552). Applicant respectfully disagrees with the Examiner's rejection and shall demonstrate that the rejection should not be sustained.

Murakami and Stefik fail to establish a prima facie case for obviousness and should not be used to sustain a rejection of Claims 16, 18 and 19 under 35 USC § 103(a).

To support rejection of any claim under 35 USC § 103(a), the references cited must satisfy the following criteria:

1. There must be some motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings;
2. There must be a reasonable expectation of success; and
3. The prior art reference (or references when combined) must teach or suggest all the claim limitations.

Applicant respectfully submits that the cited references do not offer any motivation to modify the references to make the claimed invention. Applicant also respectfully submits that the knowledge available to one of ordinary skill in the art would not have motivated the artisan to modify or combine the cited references to make the claimed invention.

Applicant notes that neither Murakami nor Stefik provide any motivation to combine the teachings of these two patents to render the claimed invention.

As an alternative to finding motivation in the reference directly, the Examiner must put forth a convincing line of reasoning as to why the artisan would have been motivated by the reference teachings to make the proposed modification. The Office Action has not provided any rationale that would support this alternative motivation requirement. The Examiner has stated that "it would have been obvious to the person of ordinary skill in the art at the time the invention to incorporate the teachings of Stefik et al into Murakami", but this statement alone is not enough. It is also necessary to provide reasoning as to why an artisan would have modified the reference to yield the claimed invention.

Murakami teaches an electronic blackboard based on electromagnetic sensing. The electromagnetic sensing means of Murakami relies on tuned

circuits to detect the location of Murakami's writing instruments.

Electromagnetic sensing is completely disparate from the technology used in Stefik, i.e. ultrasonic sensing. It is inconceivable that the artisan would have been motivated to combine the infrared transmitters taught by Stefik with Murakami's eraser because electromagnetic sensing does not require the additional synchronization signals needed in ultrasonic sensing.

Modification of the Murakami reference renders it unfit for its intended purpose.

For the Patent Office to rely on a modified reference to sustain a rejection under 35 USC § 103(a), the proposed modification of the reference can not render the prior art unfit for its intended purpose.

Murakami teaches an apparatus that relies on electromagnetic sensing. Modifying the eraser of Murakami by replacing the tuned circuits with an infrared transmitter and an ultrasonic transmitter would preclude Murakami's eraser from working with the electromagnetic based blackboard.

Because modification of Murakami would render it unfit for its intended purpose, it is respectfully submitted that it is not proper to rely on Murakami as a modified reference to sustain a rejection under 35 USC § 103(a).

3. With respect to Claims 18 and 19, Applicant deems the rejection moot in light of Applicant's showing that Murakami and Stefik can not be used to sustain a rejection of Claim 16 under authority of 35 USC § 103(a). The Applicant thereby avers that the dependant Claims 18 through 19, inclusive, all of which stem from Claim 16, are non-obvious.
4. Based on the foregoing, Applicant considers the present invention to be distinguished from the art of record. Accordingly, Applicant respectfully solicits the Examiner's withdrawal of the rejections raised in the above referenced Office Action, such that a Notice of Allowance is forwarded to Applicant, and the present application is therefore allowed to issue as a United States patent.

Respectfully Submitted,



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